

REMARKS - General**The Claims Rejection Under 35 USC § 103**

Claims 1- 2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eldan in view of Douglas and Dunn. The obvious needs to be stated that Eldan does not mention anywhere the detection of bromine and any teaching can be remotely related. It has been previously stated that the assessment of SeBr has nothing to do with the measurement of a drug-of-abuse adulterant (Bromine) and can be easily proven through and with science. In contrast the device(s) of the Smith invention employs completely different methodologies for the detection of bromine. The method is one step.

In view of Douglas and Dunn the applicant has not nor would claim the use of Evans blue, iodide salt, starch and dextran for the measurement. Mainly because it would not work for the measurement of bromine in urine used as an oxidative adulterant. The applicant fails to find in Eldan, Douglas and Dunn any references to the novel combination of buffers, indicators and methods as taught by Smith for the detection of bromine.

The Examiner should reverse the rejection of claims 1-2 under 35 U.S.C. § 103(a) as being unpatentable over Eldan in view of Douglas and Dunn. Because applicant's claims 1 - 2 recite novel physical features (i.e., it clears § 102). The novel physical distinctions of claims 1 - 2 are unobvious under § 103(a) for the following reasons. The present device produces **unexpected results** due to the inherent design and capability differences between the Smith and the cited prior art. The prior art of Eldan does not mention the detection of bromine but teaches the assessment of SeBr (not an oxidant). When the present and past devices are juxtapose the results produced are unexpected. The present device is a single step method for the analysis of bromine in urine or other fluids effectively allowing **superior** results with reference to time, cost, and accuracy and ability to do the basic claim which is the detection of bromine without the use of Evans blue, iodide salt, starch and dextran, etc. The present device **omits** certain and critical

elements of the Eldan in view of Douglas and Dunn device(s) namely the present art does not require solid support device with hydrophobic zones of reaction with chemicals such as Evans blue, iodide salt, starch and dextran, etc., to name a few. The present art by not including these elements of the prior art is in fact more capable of producing a more **clinically significant** result for the presence of bromine in urine or other fluids therefore producing a **superior** functional device. The prior art of Eldan in view of Douglas and Dunn do not explain any of the present arts novel features. Eldan in view of Douglas and Dunn fail to teach or mention in any of their specifications or claims the important step of the detection of bromine. The Examiner has not presented a convincing line of reasoning as to why the claimed subject matter as a whole, including its differences over the prior art, would have been obvious. Eldan in view of Douglas and Dunn do not teach the present art. The applicant's invention **solves a different problem**, detection of bromine without the use of the prior mentioned restrictions and limitation of Eldan in view of Douglas and Dunn.

As the Appellant and other courts have cited, hindsight view of prior art is not allowable. As the Courts have stated, "It is impermissible to use the claimed invention as an instruction manual to "template" or piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight construction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention." in re Fritch supra, 1784.

Thus the applicant submits that their invention clearly recites novel physical subject matter which distinguishes over any possible use of Eldan in view Douglas and Dunn

The Newly Amended Novel Physical features of Claims 1 – 2 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over The Reference Under § 103.

Again, Such hindsight reconstruction of an invention to support a rejection under 35 U.S.C. 103 is improper as clearly set forth by the Court of Appeals For the Federal Circuit in *In re Fritch*, 23 USPQ 2d 1780 at 1783-1784 (CAFC 1992) where it is stated, "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination" "Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures of the prior art to deprecate the claimed invention'."

For these reasons, the Examiner's rejection of claims 1 - 2 under 35 U.S.C. § 103 should be reversed.

Again, the Examiner's rejection of amended claims 1 - 2 as obvious within the meaning of 35 U.S.C. § 103. over Eldan in view of Douglas and Dunn should be reversed. Applicant's invention of claims 1 - 2 are not obvious when compared to the prior art of Eldan in view of Douglas and Dunn because such prior art as a whole does not teach applicant's invention. Rather, some of the prior art teaches various aspects of detection/assessment of SeBr, chlorine, bromine or analytes which are in no manner even slightly similar to the present art. Furthermore, no suggestion is made by any of the prior inventors to combine any of these prior art elements to form applicants' device. For these reasons applicants are entitled to allowance of amended claims 1 - 2.

"It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

In line with these decisions, recently the Board stated in Ex parte Levengood, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

"In order to establish a *prima facie* case of the obviousness, it is necessary for the examiner to present *evidence*, preferable in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. ...That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can *reconstruct* and/or explain the theoretical mechanism of an invention by mean of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the *motivating force* which would impel one skilled in the art to do what the *applicant has done*."

The Novel Physical Features Of Amended Claims 1 – 2 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over The References Under § 103.

For this reason, the Examiner's rejection of amended claims 1 - 2 under 35 U.S.C. § 103 should be reversed.

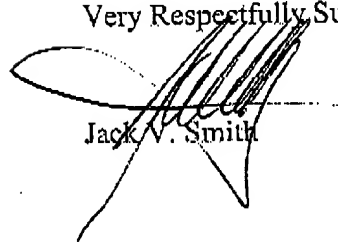
Conclusion

For all of the above reasons, applicant submits that the specification and claims are in proper form, and that the claims all define patentably over the prior art. Therefore the applicant submits that this application is now in condition for allowance, which action is respectfully solicited.

Conditional Request For Constructive Assistance

Applicants have amended the specification and claims of this application so that they are proper, definite, and define novel structure which is also unobvious. If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. § 107.03(d) and § 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very Respectfully Submitted,



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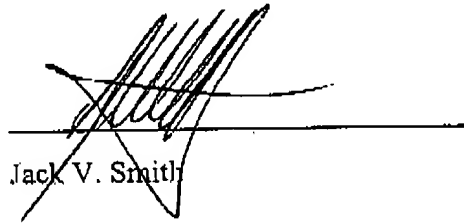
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